

REMARKS

I. Status of the Claims

Claims 1, 6, 10-27, 30-48 and 71 are pending and under consideration, claims 2- 5, 7-9, 28, 29 and 49-70 having been previously canceled without prejudice against their reintroduction into this or one or more timely filed continuation, divisional or continuation-in-part applications. With this Amendment, claims 1, 6 and 27 are being amended. Thus, after entry of this Amendment, claims 1, 6, 10-27, 30-48 and 71 remain pending and under consideration.

Applicants understand that the previous rejections under 35 U.S.C. §112, second paragraph (indefiniteness) and 35 U.S.C. §103(a) as allegedly obvious over Schmukler in view of Gutierrez-Armenta and Dev have been withdrawn.

II. Amendments

Claims 1 and 27 are amended to recite step a), in which the seed containing the cell is immersed in water so as to allow the seed to absorb water. Support for this amendment is found throughout the Examples, as well as at least in paragraph [0154] of the published application US 2006/0188992.

Claim 6 is amended to bring it into accord with amended claim 1.

No new matter is added by way of these amendments.

IV. Rejection under 35 U.S.C. §103(a)

Claims 1, 6, 10-27, 30-48 and 71 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Dev (of record) in view of Porter (of record).

This rejection is respectfully traversed in light of the amendment to the claims.

A. The Cited Art

DEV discloses a method for producing genetically modified plants via electroporation in the absence of cell-wall degrading enzymes.

PORTER discloses inoculation of seeds with bacteria or particulate matter.

B. Analysis

Applicants disagree that the skilled artisan would have, without benefit of hindsight, combined these disparate references with any reasonable expectation of arriving at Applicants' claimed subject matter.

As acknowledged by the Examiner, Dev fails to teach or suggest that the plant cell having an intact cell wall and contained in a seed is subjected to depressurization to about 0.096 MPa below atmospheric pressure prior to putting the seed and the nucleic acid under conditions to induce electroporation.

Porter relates to inoculation of seeds with bacteria, and is completely silent with respect to electroporation of a nucleic acid.

However, without acquiescing to the Examiner's allegations, but solely to expedite prosecution of the application, Applicants have amended the claims to recite that the seed containing the cell is immersed in water so as to allow the seed to absorb water.

Porter teaches that the object of the disclosed invention is to obtain inoculation of seeds without soaking and resultant swelling whereby the protective seed coat or hull is deleteriously ruptured or destroyed. (See column 2, lines 33-36 and 47-52; and column 3, lines 2-7). Furthermore, Porter teaches that "the total time of contact of the seeds with the slurry was approximately 10 minutes, which was insufficient to cause any soaking of the seeds and swelling thereof." (See column 4, lines 3-6). Porter clearly teaches away from the claims as presently amended.

Thus, even assuming, *arguendo*, that the skilled artisan would have combined these references, the presently claimed method involving a step in which the seed containing the cell is immersed in water before depressurizing the container is not taught or suggested by the references, alone or in combination.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103.

CONCLUSION

This after-final amendment is a *bona fide* attempt to advance the application to allowance.

Claims 1, 6, 10-27, 30-48 and 71 are believed to satisfy all of the criteria for patentability, and an early indication of the same is therefore kindly requested.

No fees are believed to be due in connection with this Amendment. However, the Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment, to King & Spalding LLP Deposit Account No. 50-4616.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 590-1932.

Respectfully submitted,
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